

## REMARKS

The present application includes pending claims 1-38, all of which have been rejected. In particular, claims 1-9, 11-15 and 24-31 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 6,813,775 ("Finseth") in view of U.S. 5,857,190 ("Brown"). Claims 16-23 and 33-38 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 7,065,778 ("Lu") in view of Finseth. Claims 10 and 32 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Finseth in view of Brown and Lu. The Applicants respectfully traverse these rejections for at least the reasons previously discussed during prosecution and the following:

Initially, the Applicants note that a goal of patent examination is to provide a prompt and complete examination of a patent application.

**It is essential that patent applicants obtain a prompt yet complete examination of their applications.** Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the *initial review* of the application, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, Office personnel *should state all reasons and bases for rejecting claims in the first Office action*. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. **Whenever practicable, Office personnel should indicate how rejections may be overcome and how problems may be resolved.** A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.

Manual of Patent Examining Procedure (MPEP) § 2106(II) (emphasis added). As such, the Applicants assume, based on the goals of patent examination noted above, that the Office Action has set forth "all reasons and bases" for rejecting the claims.

Further, this Response does not amend any of the pending claims. Therefore, this Response cannot raise any new issues that would require a further search.

**I. The Proposed Combination Of Finseth and Brown Does Not Render Independent Claim 1 Unpatentable**

Independent claim 1 recites, in part, “notifying the at least a second user, via the communication network, of the consumption of the requested media by the first user, if the pre-defined set of characteristics for the requested media matches the at least one user-selected characteristic [associated with media]; and refraining from notifying the at least a second user, via the communication network, of the consumption of the requested media by the first user, if the pre-defined set of characteristics for the requested media does not match the at least one user-selected characteristic [associated with media].” The Office Action cites Finseth as disclosing these limitations. *See* July 21, 2008 Office Action at page 5.

Finseth “relates to systems and methods for presenting media programs to subscribing viewers, and in particular to a system and method for sharing viewer preferences among viewers.” Finseth at column 1, lines 16-19. Finseth discloses a method that “transmit[s] at least a portion of the first viewer preference information to a second user for storage in a memory of a second user device.” *See id.*

Initially, claim 1 is clear that the media is “requested.” Thus, one user requests the media from the another user. However, Finseth does not describe, teach or suggest that one user “requests” media from another user. Instead, in Finseth, one subscriber decides to share information with another subscriber. After the subscriber decides, without any prompting from the other, to share that information, Finseth discloses that the other may choose to receive portions of the information that the other decided to share. *See id, e.g.*, at column 17, lines 29-44. However, Finseth does not describe, teach or suggest that the recipient first requested any

information from the sharer. Instead, the sharer decides to share information with the recipient. The recipient may then determine portions of the information to receive.

In particular, Finseth discloses the following:

The method comprises the steps of storing first user viewer preference information characterizing media programs selected by the first user in a memory of a first user device, and transmitting at least a portion of the first viewer preference information to a second user for storage in a memory in a second user device.

*Id.* at column 2, lines 22-33. Further,

**When the user wants to share viewing preference information, the user initiates the process** using, for example, remote control 86. To share viewing preference information a user must first select with whom to share the information, which is represented by box 132.

*Id.* at column 12, lines 23-28 (emphasis added). *See also id.* at column 13, lines 35-48 (“When a user decides to share viewing information with a group, the user initiates a multi-step process...”).

Thus, Finseth is clear that the sharing process is initiated by a sharer selecting another subscriber(s) with whom to share the viewer preference information. The process does not begin, however, with the recipient requesting anything from the sharer. Thus, Finseth does not describe, teach or suggest “notifying the at least a second user, via the communication network, of the consumption of the **requested media** by the first user, if the pre-defined set of characteristics for the **requested media** matches the at least one user-selected characteristic [associated with media]; and refraining from notifying the at least a second user, via the communication network, of the consumption of the **requested media** by the first user, if the pre-defined set of characteristics for the **requested media** does not match the at least one user-

selected characteristic [associated with media],” as recited in claim 1. For at least this reason, the Applicants respectfully request reconsideration of the rejection of claim 1.

Moving on, the Office Action cites Finseth at column 12, lines 30-45 and column 15, lines 52-65 as disclosing “notifying the at least a second user, via the communication network, of the consumption of the requested media by the first user, if the pre-defined set of characteristics for the requested media matches the at least one user-selected characteristic [associated with media]; and refraining from notifying the at least a second user, via the communication network, of the consumption of the requested media by the first user, if the pre-defined set of characteristics for the requested media does not match the at least one user-selected characteristic [associated with media].” See July 21, 2008 Office Action at page 5. Thus, the Applicants will address each of these cited portions.

First, Finseth at column 12, lines 30-45 states the following:

A user must also select what information to share with the selected recipient, as represented by box 134. A user may choose to share the entire contents of his/her user-specific sub-history table with the selected recipient. A user may choose to tell the recipient only about a specific television program. Using remote control 86 (FIG. 3) or another input device such as an infrared keyboard, a user can also share specific comments or reviews regarding a television program. However, for privacy reasons, a user may wish to send only summary or depersonalized information regarding his or her viewing preferences where only certain attributes from his or her preference history are shared with others.

Receiver 64 then transmits at least a portion or a processed version of the selected viewing preference information to the selected recipient (e.g. second user) via telephone lines or the Internet, which is represented in box 136.

Finseth at column 12, lines 30-45. This portion of Finseth states that a “user may choose to share the entire contents of his/her **user-specific sub-history table**.” See *id.* (emphasis added). The

user-specific sub-history table stores "attributes of the television program viewed by a user." *See id.* at column 12, lines 20-23.

These cited portions of Finseth indicate that the user selects which information to send, but not that another subscriber actually requests the information. Notably, the cited portion of Finseth above discloses that a user **must** select which information to share with a recipient. Once selected, that information is then shared with the recipient. However, this cited portion of Finseth does not describe, teach or suggest that such information is shared only if pre-defined characteristics of media match user-selected characteristics. That is, this portion of Finseth does not describe, teach or suggest "notifying the at least a second user, via the communication network, of the consumption of the requested media by the first user, if the **pre-defined set of characteristics for the requested media matches the at least one user-selected characteristic [associated with media]**; and refraining from notifying the at least a second user, via the communication network, of the consumption of the requested media by the first user, if the **pre-defined set of characteristics for the requested media does not match the at least one user-selected characteristic [associated with media]**," as recited in claim 1. Instead, in Finseth, as noted above, a user selects information to share, and then that information is sent to the recipient **without any determination as to whether that information matches or does not match another set of information.**

Next, **Finseth at column 15, lines 52-65** recites the following:

The "How Much Detail?" category 198 allows a user to control the amount of viewing preference information to share with the destination. For privacy reasons, a user may not wish to share the entire contents of his/her user-specific sub-history table. Instead, a user may only wish to share a summary of the attributes contained therein. A summary would not include the titles of the viewed television programs or the channel definitions of the channels

where the program was shown, but would include certain attributes of the viewed programs so that only a user's general viewing preferences would be communicated to others. A user could further restrict the amount of information communicated to others by specifically selecting contents of its sub-history table to be sent.

*See id.* at column 15, lines 52-65. This portion of Finseth merely discloses that a user can control the amount of preference information to share with others. That is, the user may share a sub-set of the information within his/her sub-history table. Similar to the other cited portion of Finseth, though, this portion does not describe, teach or suggest “notifying the at least a second user, via the communication network, of the consumption of the requested media by the first user, if the **pre-defined set of characteristics for the requested media matches the at least one user-selected characteristic [associated with media]**; and refraining from notifying the at least a second user, via the communication network, of the consumption of the requested media by the first user, if the **pre-defined set of characteristics for the requested media does not match the at least one user-selected characteristic [associated with media]**,” as recited in claim 1.

The Office Action states, however, the Finseth “has been relied upon to teach a method of transmitting a select portion of first viewer preference information to a second user in a memory of a second user device, whereby a user can control the type & amount of preference information to share with others....” *See* July 21, 2008 Office Action at page 2. The Office Action also states that Finseth “teach[es] that the delivery of viewing preference information from a 1<sup>st</sup> user to a 2<sup>nd</sup> user occurs **only if the characterizing information from the associated program guide matches that of the media characteristics chosen by a 1<sup>st</sup> user** (col. 12, lines 30-45; col. 15, lines 52-65).” *See id.* at pages 2-3.

As explained above, however, these cited portions of Finseth do not describe, teach or suggest that delivery of viewing preference information from a first user to a second user is predicated on a match of any kind. Instead, they disclose that information is shared based on what a user actually selects to send, as opposed to any kind of match. The portions of Finseth that the Office Action cites disclose that a user **must select which information to share with a recipient**. See Finseth at column 12, lines 30-31 (“A user **must** select what information to share with the selected recipient”). **Once selected** (as opposed to a determination of any “match”), that information is then shared with the recipient. Thus, Finseth discloses that information is shared based on what the user selects as the information to share with another. Once the user affirmatively selects the information to share, the information is then shared with the recipient. In this way, a user can control the amount of preference information to share with others. See Finseth at column 15, lines 52-65. Again, Finseth discloses that information is sent based on what a user selects, but not because of a match, in general, and certainly not because of “**pre-defined set of characteristics for the requested media matches the at least one user-selected characteristic [associated with media],**” in particular.

The Office Action also states that Finseth “teach[es] that a user is able to select which information to send to a 2<sup>nd</sup> location and whether or not to make this process automated, thereby allowing the system to automatically send the appropriate view preference information matching user selected characteristics and refrain from sending those that do not (col. 15, lines 51-65; col. 16, lines 29-38).” See July 21, 2008 Office Action at page 3. Again, the Office Action cites to Finseth at column 15, lines 51-65. As noted above, however, this portion of Finseth merely discloses that a user can control the amount of preference information to share with others. That is, the user may share a sub-set of the information within his/her sub-history table. It does not,

however, describe, teach or suggest “notifying the at least a second user, via the communication network, of the consumption of the requested media by the first user, if the **pre-defined set of characteristics for the requested media matches the at least one user-selected characteristic [associated with media]**; and refraining from notifying the at least a second user, via the communication network, of the consumption of the requested media by the first user, if the **pre-defined set of characteristics for the requested media does not match the at least one user-selected characteristic [associated with media]**,” as recited in claim 1.

Nevertheless, the Office Action also cites to Finseth at column 16, lines 29-36, which states the following:

If a user has set up sharing features for the specific destination without requiring user verification, then receiver 64 (after waiting the length of the sharing interval) automatically sends the appropriate viewing preference information to the particular destination without prompting the user. After sending viewer preference information to the destination, receiver 64 continues to update a user's viewing preference sub-history table by tracking the user's viewing history, which is represented by box 204, and the process repeats.

*Id.* at column 16, lines 29-36. Notably, this portion of Finseth is clear that a user who wishes to share this information sets up the sharing features. There is no “request” from the particular recipient. Instead, the sharer simply decides to share the information with the “particular destination,” and the information may be automatically sent to that destination. If the time interval has not elapsed, new consumption by a user is not shared at the time of consumption. Instead, it is shared when the current running time interval elapses. In general, Finseth does not describe, teach or suggest that the “second user” requests anything from the “first user.” *See id.* at Abstract, column 2, lines 22-33, column 12, lines 23-38 and column 13, lines 35-48. Finseth does not describe, teach or suggest “notifying the at least a second user, via the communication



network, of the consumption of the **requested media** by the first user, if the **pre-defined set of characteristics for the requested media matches the at least one user-selected characteristic [associated with media]**; and refraining from notifying the at least a second user, via the communication network, of the consumption of the requested media by the first user, if the **pre-defined set of characteristics for the requested media does not match the at least one user-selected characteristic [associated with media]**,” as recited in claim 1.

Thus, for at least these reasons, the Applicants respectfully request reconsideration of the rejection of claim 1 as being unpatentable over Finseth in view of Brown. The Applicants respectfully submit that the proposed combination of Finseth and Brown does not render claims 1-9 unpatentable.

**II. The Proposed Combination Of Finseth and Brown Does Not Render Independent Claims 11 and 24 Unpatentable**

Claim 11 recites, in part, “sending a notification via a communication network if the pre-defined set of characteristics for the requested media matches the at least one media characteristic [associated with a user]; and refraining from sending a notification if the pre-defined set of characteristics for the requested media does not match the at least one media characteristic [associated with a user].” Independent claim 24 recites similar limitations. The Applicants respectfully submit that the proposed combination of Finseth and Brown does not render claims 11-15 and 24-31 unpatentable for at least the reasons discussed above with respect to claim 1.

**III. The Proposed Combination Of Lu and Finseth Does Not Render Independent Claim 16 Unpatentable**

Claim 16 recites, in part, “server software that ... notifies, via a communication network, the associated second network address if the at least one media characteristic [associated with the

second user] matches the at least one pre-defined characteristic.” Independent claim 33 recites similar limitations. The Applicants respectfully submit that the proposed combination of Lu and Finseth does not render claims 16-23 and 33-38 unpatentable for at least the reasons discussed above.

#### **IV. The Proposed Combination Of Finseth, Brown And Lu**

The Applicants respectfully submit that the proposed combination of Finseth, Brown and Lu does not render claims 10 and 32 unpatentable for at least the reasons discussed above.

#### **V. Conclusion**

In general, the Office Action makes various statements regarding the pending claims and the cited references that are now moot in light of the above. Thus, the Applicants will not address such statements at the present time. However, the Applicants expressly reserve the right to challenge such statements in the future should the need arise (e.g., if such statement should become relevant by appearing in a rejection of any current or future claim).

The Applicants respectfully request reconsideration of the claim rejections for at least the reasons discussed above. If the Examiner has any questions or the Applicants can be of any assistance, the Examiner is invited to contact the undersigned attorney.

The Commissioner is authorized to charge any necessary fees, or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Account No. 13-0017.

Respectfully submitted,

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